



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,282	12/17/1999	DENNIS RUBEN	42543.3	9978

7590 11/07/2002

JAMES E MARINA ESQ
WINSTON & STRAWN
200 PARK AVENUE
NEW YORK, NY 10166

EXAMINER

GARLAND, STEVEN R

ART UNIT PAPER NUMBER

2125

DATE MAILED: 11/07/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,282

Applicant(s)

RUBEN ET AL.

Examiner

Steven R Garland

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2121

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 4-11, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel 4,732,411 in view of Kutsuma 5,905,652.

Siegel teaches using a label having a miniature photograph of the patient on a prescription container. Siegel teaches that the picture is taken of the patient and then stored in computer memory so that it can be produced on demand. See the abstract; figure 1; col. 2, lines 1-64; col. 3, lines 1-66; and claim 1.

Siegel however does not specifically state that two computers can be used; that databases are used, that a laser printer is used, or that a digital camera is used.

Kutsuma teaches the use of a digital camera; inputting a picture into a computer; transmitting a picture from one computer to another computer and combining the picture with other prescription information and printing the combined information. Kutsuma also teaches storing the picture and prescription information in separate memories which form databases. Kutsuma also teaches that if the required picture is not stored in memory taking a picture and storing the picture in memory. See fig. 6; col. 4, lines 26-48; col. 6, lines 13-27.

It would have been obvious to one of ordinary skill in the art to modify Siegel in view of Kutsuma to use a printer, camera, databases, and multiple computers as taught by Kutsuma to produce a label with a patient picture and other information such as medication pictures and prescription information. This would allow printing a label at various locations in case a printer fails or sending the information to different pharmacies and insure the correct patient receives the correct medications.

Further it would have been obvious to one of ordinary skill in the art to modify Siegel and Kutsuma to use a laser printer to print the labels so that a sharp image results.

In response to applicant's arguments, Siegel is being relied on for the teachings above including the use of a patient photo on a label and Kutsuma is being relied on for the teachings above including the use of databases, use of a digital camera, etc. and not for use of a photo to identify the patient which Siegel teaches. Further Kutsuma teaches in col. 6, lines 13-27 a computer network which allows picture and other information to be transmitted from one computer to another not solely to the computer

the camera is connected to. Further Siegel teaches obtaining the photograph when the patient is admitted to the care facility (doctors office or hospital). See col. 3, lines 1-30 of Siegel.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1,7-11,14,16, and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Cloninger WO99/17218.

Cloninger discloses use of a digital camera to take a picture of the patient; electronically digitizing, storing, and accessing the image of the patient; tracking order, issue, and administration of medication for billing purposes; transmitting prescription and picture information from a system computer to the pharmacy computer where the prescription is filled and a label is generated with a patient picture. See the abstract; pages 3,4,6,9,11-16,18-20 and the figures.

6. Claims 4-6,15,17,19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloninger WO99/17218 in view of Kutsuma 5,905,652.

Cloninger discloses use of a digital camera to take a picture of the patient; electronically digitizing, storing, and accessing the image of the patient; tracking order, issue, and administration of medication for billing purposes; transmitting prescription and picture information from a system computer to the pharmacy computer where the

prescription is filled and a label is generated with a patient picture. See the abstract; pages 3,4,6,9,11-16,18-20 and the figures.

Cloninger however does not teach the use of separate databases or the use of laser printer to implement the printer.

Kutsuma teaches the use of a digital camera; inputting a picture into a computer; transmitting a picture from one computer to another computer and combining the picture with other prescription information and printing the combined information. Kutsuma also teaches storing the picture and prescription information in separate memories which form databases. Kutsuma also teaches that if the required picture is not stored in memory taking a picture and storing the picture in memory. See fig. 6; col. 4, lines 26-48; col. 6, lines 13-27.

It would have been obvious to one of ordinary skill in the art to modify Cloninger in view of Kutsuma and use separate databases for the various types of information so that it could be easily modified and retrieved.

Further it would have been obvious to one of ordinary skill in the art to modify Cloninger and Kutsuma to use a laser printer to print the labels so that a sharp image results.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-9759. The examiner can normally be reached on Monday-Thursday from 6:30 to 5:00.

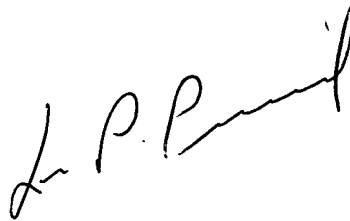
Art Unit: 2121

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239 for official faxes; for after final faxes 703-746-7238; and for non-official faxes 703-746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

sr 6

Steven R Garland
Examiner
Art Unit 2121



LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100